

**REMARKS****Overview**

Claims 1-10 are pending in this application. Claims 1, 3, 9 and 10 have been amended to place the case in proper form for allowance or better form for appeal. In particular, these claims have been amended to positively recite the contents of the apparatus, namely "a drink item" and "a snack item". Reconsideration and passage to issuance is therefore respectfully requested.

**Issues Under 35 U.S.C. § 103**

Claims 1, 3, and 5-10 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U. S. Patent No. 6,349,820 to Kelley et al. in view of U. S. Patent No. 5,595,302 to Maydwell et al and U. S. Patent No. 4,308,951 to Walker, Jr. It appears from the Examiner's remarks that the Examiner understands differences between structures in the present invention and the prior art as well as differences in the problems being solved, however, notes that the drink item and snack item are not positively recited in the claims (Office Action, pages 4-5). Thus, the claims have been amended to positively recite these elements.

In particular, claim 1 has been amended to positively recite "a snack item" and "a drink item". Claim 3 has been amended to also positively recite the "drink item". Claim 9 has been amended to positively recite "placing the drink item in the apparatus and securing the drink item with the at least one drink restraint; and placing the snack item in the apparatus and securing the snack item with the at least one snack restraint." Claim 10 has been amended to positively recite "a drink box".

Also, it is observed that Kelley does not disclose "at least one side of the top portion comprising a right-on wipe-off surface." The Examiner does not specifically indicate where in

Kelley disclosure is made concerning such a write-on wipe-off surface and a review of Kelley indicates that Kelley does not disclose this limitation. The Examiner's position is that Kelley's surface is capable of performing such a function (Office Action, page 4).

It is respectfully submitted that this is a structural limitation not met by Kelley. The term "write-on wipe-off" is well-known as it relates to school supplies as a plastic or acrylic surface suitable for use with dry erase or wet erase markers. Kelley does not disclose such a surface. As Maydwell and Walker, Jr. do not remedy this deficiency, it is respectfully submitted that this rejection to claims 1, 3 and 5-10 must be withdrawn for this reason as well.

It is further observed that Kelley is directed towards a book-shaped device for holding a cuisine-specific collection of herbs and spices and a business method for providing cuisine-specific herbs and spices. Thus, it is not surprising that Kelley makes no disclosure that it includes compartments/restraints for holding drink items or snack items. Claim 1 now positively recites "a drink item" and "a snack item". Claim 1 specifically requires "wherein one side of the bottom portion includes at least one drink restraint adapted for holding the drink item and at least one snack restraint adapted for holding the snack item." Similarly, claim 9 requires "at least one drink restraint for holding a drink item and at least one snack restraint for holding a snack item." The Examiner indicates that the compartments/restraints of Kelley are "capable of holding a drink item and a snack item." Such an observation whether true or not is irrelevant in the context of an obviousness-type rejection as Kelley does not specifically disclose the claimed structures and it is not addressed towards solving the same problem. "The problem solved by the invention is always relevant." In re Wright, 838 F.2d 1216, 6 U.S.P.Q.2d 1959, 1961 (Fed. Cir. 1988). The Examiner indicates that In re Dillion overrules In re Wright (Office Action, page 4). To consider In re Dillion, 919 F.2d 688 (Fed. Cir. 1990) to overrule In re Wright as applied to this

issue is not a proper reading of that case. In re Dillion did not hold the Examiner need not consider the problem being solved, but rather merely that structural similarity coupled with the same or similar utility is required to provide a *prima facie* case of obviousness. The utility of an invention, of course, relates back to the problem being solved.

The utility here is different than in Kelley because Kelley is directed towards solving a very different problem. Kelley is directed towards holding a cuisine-specific collection of herbs and spices and not to storing and transporting school supplies and snacks. It is the utility of the invention as a whole that must be considered as opposed to the utility of a particular structural element.

It is respectfully submitted that as Kelley is not directed towards addressing the same problem as in the Applicant's claimed invention, and that the Examiner needs to further consider the relevancy of Kelley. Moreover, it is also respectfully submitted that Kelley is not available under 35 U.S.C. § 103 as it is not within the field of the inventor's endeavor and was not directly pertinent to the particular problem with which the inventor was involved. King Instrument Corp. v. Otari Corp., 767 F.2d 853, 226 U.S.P.Q. 403 (Fed. Cir. 1985). Therefore, these rejections should also be withdrawn for this independent reason as well.

Claim 2 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over the references applied to claim 1 and further in view of U. S. Patent No. 5,950,834 to Woodnorth et al. The deficiencies with respect to the rejection to claim 1 have already been addressed. Woodnorth does not remedy these deficiencies, therefore this rejection to claim 2 must also be withdrawn.

Claim 4 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over the references as applied to claim 1 and further in view of Official Notice. In particular, the

Examiner indicates that it is old and conventional practice to provide a student's backpack for holding lunch and school supplies for a student having straps for carrying the backpack. As claim 4 depends from claim 1, it is respectfully submitted that this rejection to claim 4 should be withdrawn for the reasons previously expressed with respect to claim 1. There is also an independent reason for patentability of claim 4. In particular, as Kelley is not directed towards an apparatus for carrying school supplies or for carrying lunch (but rather a spice holding device), it would not have been obvious to add backpack straps to Kelley as Kelley is not directed towards the same problem addressed by the Applicant's invention. Why would a spice rack have backpack straps? Therefore, it is respectfully submitted that this rejection to claim 4 should also be withdrawn.

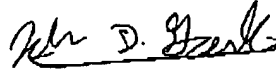
#### **Conclusion**

Therefore, it is respectfully submitted that all claims are in proper form for immediate allowance and reconsideration and passage to issuance is therefore respectfully requested. Should the Examiner not find all claims in proper form for immediate allowance, the Examiner is encouraged to telephone the above undersigned attorney in order to reach mutual agreement as to appropriate claim language in order to expedite prosecution of this case.

No fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,



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